

REMARKS

Summary of Changes Made

By this Amendment, claims 1, 13, 17 and 22 have been amended to recite a guanidine material and new claim 23 has been added. Claims 5 has been amended to eliminate the limitation relating to the guanidine material that is now recited in claim 1 and claim 7 has also been amended to accommodate the revision to claim 1. Claims 4 and 6 have been canceled herein. The application was originally filed with claims 1-22. In a previous amendment, claims 2, 15, and 21 were canceled. Accordingly, claims 1, 3, 5, 7-14, 16-20, 22 and 23 (18 claims) remain pending in the application. No new matter is added by this amendment.

Claim Rejections - 35 U.S.C. §102(b) (Rutz)

The Examiner has rejected claims 1, 3, 8, 13, 14, and 16-20 under 35 U.S.C. 102(b) as anticipated by Rutz et al., U.S. Pat. No. 5,154,881 ("Rutz"). The Examiner contends that Rutz discloses a composition for making a sintered metal article comprising an iron-based powder, graphite and a solid amide wax lubricant. The Examiner admits that Rutz fails to teach that at least a portion of the lubricant liquefies upon the application of pressure. Nevertheless, the Examiner states that the disclosed lubricant is the same as that recited in instant claim 8, and hence is capable of liquefying under pressure. The Examiner then shifts the burden to Applicant to distinguish the prior art. The Examiner further asserted that the subject matter of claim 3 is disclosed in Rutz, and that the subject matter of claims 14, 16, and 18-20 is inherently disclosed in Rutz.

Applicants respectfully traverse the rejections. Initially the Examiner will note that independent claims 1, 13, and 17 have been amended to recite the presence of a guanidine material. Rutz fails to disclose a guanidine material, and hence Rutz fails to disclose all limitations of claim 1. On this basis alone, it is believed that independent claim 1, and amended independent claims 13 and 17 are novel over Rutz. By extension, it is believed that all rejected claims, 1, 3, 8, 13, 14, and 16-20, are patentable over Rutz.

Claim Rejections - 35 U.S.C. §103(a) (Rutz and Schofalvi)

The Examiner rejected claims 1, 5-14, 16-20, and 22 under 35 U.S.C. § 103(a) as obvious in view of Schofalvi et al., U.S. Pat. App. Pub. No. 2003/0220424, ("Schofalvi") in view of Rutz.

The Examiner asserts that Schofalvi discloses a composition for powder metallurgy comprising an inorganic powder, a binder composition, which comprises an aliphatic polyester polymer, an ethylenebisamide wax, and a guanidine wetting agent, as well as a debinding accelerator. The Examiner believes that the subject matter of claims 5, 7-12, 14-20 and 22 is disclosed in Schofalvi. The Examiner admits that Schofalvi fails to disclose the use of a graphite powder. The Examiner concludes that Rutz fills the gap of Schofalvi by disclosing the use of a graphite powder.

The combination of Schofalvi and Rutz is improper, hence the *prima facie* case of obviousness fails. Prior art references must be considered for all they teach. When combining prior art references, the objectives and mode of action of each invention must be left intact. Rutz concerns the hot compaction of metal powders at temperature of from about 100°C to about 370°C. Schofalvi concerns the use of a binder system and the compaction of metal powders at ambient un-elevated operating temperatures (such ambient temperatures also being taught in the present application). Hence, the two modes of action of Rutz and Schofalvi are at odds with one another, and their combination is improper. One would not look to a hot compaction reference such as Rutz for guidance on how to modify a reference such as Schofalvi that concerns compaction at normal, ambient operating temperatures. Moreover, one would never use the lubricant system of the present invention at the elevated hot compaction temperatures taught by Rutz, since Rutz operates above the melting temperature of applicant's guanidine lubricant system. Thus, the teachings of Rutz are clearly not applicable to the present invention. Additionally, it must be noted that although Schofalvi mentions the use of a guanidine material, such use is intended as a binder, not a lubricant as taught and claimed in the present invention, and thus such reference is not material to the claims of the present application that specify the use of a guanidine material as a lubricant. Thus, it is submitted that the pending claims are allowable over the Schofalvi and Rutz references.

New Claim

New claim 23 has been added to round out claim coverage. Claim 23 recites that the compaction (i.e., pressure) is carried out at no more than about 140°F (about 60°C). On this basis alone, claim 23 is patentably distinguished over all cited prior art in any combination.

Comments

Applicants expressly acknowledge that the terminal disclaimer has been accepted and made of record, and that the section 112 rejections have been overcome.

Applicants expressly acknowledge that the rejections levied in the previous Office Action have been mooted in light of the new grounds of rejection. Applicants understand this to mean that the previous arguments were successful in overcoming said previous rejections, and hence, that the claims as previously presented, are patentable over the prior art references cited in the previous Office Action.

CONCLUSION

Based on the foregoing, the Applicants respectfully request entry of the instant amendment and a Notice of Allowability for claims 1, 3, 5, 7-14, 16-20, 22 and 23.

If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application. If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 18-0160, our Order No. APX-12571.001.

Respectfully submitted,

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